

REMARKS

The Office Action has been carefully considered. The present amendment is intended to be a complete reply thereto and to place the case in condition for allowance. A petition and fee for a one months extension of time is filed herewith..

The specification has been amended. Support for the amendment to the specification is found in the original PCT/GB99/00567 application as filed and published as WO 99/44756.

Claims 45-47 and 56-57 have been cancelled. Claims 31 and 45 have been amended. Claim 31 has support in cancelled claims 45-47. Claim 45 has been amended to recite proper Markush language. Claim 62-90 has been added. Support for claim 62 is found in the specification as presently amended on page 5, third full paragraph. Claims 63-90 has support in the specification as currently amended and in the PCT application as originally filed.

Claims 31-44, 48-55, and 58-90 are pending

THE SPECIFICATION PROPERLY PROVIDES WRITTEN DESCRIPTION FOR THE CLAIMS

Claim 48 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time of the application. Applicant respectfully traverses the rejection.

The specification has been amended to provide support for the claim. The amendment to the specification is supported by the original PCT application which published as WO 99/44756. Because WO 99/44756 and the entire contents thereof are equivalent to a regular national filing in the United States in accordance with the provisions of the 35 U.S.C. § 363, the present

amendment to the specification does not constitute new matter. The present amendment to the specification has support in WO 99/44756, page 3, second and last full paragraphs; page 5, first full paragraph; page 5, third full paragraph to page 6, second full paragraph; page 6, fourth full paragraph; and page 8, first, second and third full paragraphs. The present amendment merely recaptures material that was disclosed in the PCT application, which, pursuant to 35 U.S.C. § 363, has the effect, from its international filing date, of a national application for patent regularly filed in the Patent and Trademark Office. *See* 35 U.S.C. § 363. Further, because the present application is a national stage application of WO 99/44756 under 35 U.S.C. § 371, the present amendment does not constitute new matter as it has support in WO 99/44756.

Moreover, the silanes of claims 48 and 49 were disclosed in the PCT application as filed, such silanes must be considered to be present in the application as filed before the U.S. Patent and Trade Mark Office in accordance 35 U.S.C. § 371. Claims 48 and 49 do not, therefore, contain subject matter which extends beyond the application as filed.

THE CLAIMS ARE DEFINITE

Claims 44 and 45 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting improper Markush language. Claim 45 has been cancelled herein; therefore, applicant will address only the rejection with respect to claim 44. Claim 44 has been amended to recite proper Markush language as suggested by the Examiner. Therefore, the claims are now definite; and withdrawal of the rejection is respectfully solicited.

THE CLAIMS ARE NOT ANTICIPATED

Claim 31-33, 36-37, 42-44, 51-52, and 58-61 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 97/16582 A1 to Shimizu et al. Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Shimizu fails to disclose that the "non-metallic chemical coating comprises a two component organic polymer or chromium, silicon and an organic active species or one or more of yttrium, elements in the lanthanum series of the periodic table, silanes or azoles" as required by amended claim 31. These limitations are from cancelled claims 45-47, which the Examiner has indicated as being allowable. Specifically, on paragraph 17 of the Office action, the Examiner states that "the prior art does not teach or fairly suggest the use of a non-metallic coating comprising an oxyanion, ..., whereby the non-metallic chemical coating additionally comprises: a two-component organic polymer [claim 45]; chromium, silicon, and an organic active species [claim 46]; one or more of yttrium, elements on the lanthanum series or the periodic table, silanes or azoles... [claim 47]" Therefore, the Examiner has acknowledged that claim 31, as presently amended, is allowable over the prior art.

Because Shimizu et al. fail to disclose every element of the claimed invention, the rejection under 35 U.S.C. § 102(b) should be withdrawn.

THE CLAIMS ARE NOT OBVIOUS

Claims 34, 38-41, and 54-55 stand rejected under 35 U.S.C. § 103(a), as being obvious over Shimizu et al. (WO 97/16582 A1). Claims 31-34, 36-44, and 49-52, and 59-60 stand rejected under 35 U.S.C. § 103(a), as being obvious over Murase (U.S. Patent No. 4,305,994). Claims 31-34, 43-44, 50, 52-55, and 58-61 stand rejected under 35 U.S.C. § 103(a), as being obvious over Jones et al. (U.S. Patent No. 5,725,944) or Heyes (U.S. Patent No. 5,238,517). Claims 36-42, 49, and 51 stand rejected under 35 U.S.C. § 103(a), as being obvious over Jones et al. or Heyes, and further in view of Collier et al. (U.S. Patent No. 4,881,975). Claim 35 stands rejected under 35 U.S.C. § 103(a), as being obvious over Shimizu et al, Murase, or Jones et al., and further in view of Baker et al. (U.S. Patent No. 3,775,151). Claim 61 stands rejected under 35 U.S.C. § 103(a), as being obvious over Murase, and further in view of Shimizu et al.

Applicant respectfully traverses the rejection.

Independent claim 31 has been amended to include the limitations of allowable claims 45-47. Claim 31 now requires that “the non-metallic chemical coating comprises a two component organic polymer or chromium, silicon and an organic active species or one or more of yttrium, elements in the lanthanum series of the periodic table, silanes or azoles”. In paragraph 17 of the Office action, the Examiner states that “the prior art does not teach or fairly suggest the use of a non-metallic coating comprising an oxyanion, as set forth in claim 31, whereby the non-metallic chemical coating additionally comprises: a two-component organic polymer [claim 45]; chromium, silicon, and an organic active species [claim 46]; one or more of

yttrium, elements on the lanthanum series or the periodic table, silanes or azoles... [claim 47]”

Therefore, the Examiner has acknowledged that the claim 31, as presently amended, is allowable over the prior art.

Claims 32-44, 48-55, and 58-62 all depended, directly or indirectly on independent claim 31. Therefore, because the dependent claim 31 is allowable over the prior art, the dependent claims should also be allowable.

ALLOWABLE SUBJECT MATTER

Applicant gratefully acknowledges the Examiner indicating claims 45-48 and 56-57 as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In allowing the claims, the Examiner states that “the prior art does not teach or fairly suggest the use of a non-metallic coating comprising an oxyanion, as set forth in claim 31, whereby the non-metallic chemical coating additionally comprises: a two-component organic polymer [claim 45]; chromium, silicon, and an organic active species [claim 46]; one or more of yttrium, elements on the lanthanum series or the periodic table, silanes or azoles... [claim 47]”. Claim 31 has been amended to include the limitations of claims 45-47. Therefore, independent claim 31 is now allowable.

Further, new claims 63-90, specifically recite that the non-metallic chemical coating comprises silanes. Because the Examiner has stated that “the prior art does not teach or fairly suggest the use of a non-metallic coating comprising ... silanes [claim 47] ...”, new claims 63-90 should also be allowable over the prior art of record.

CONCLUSION

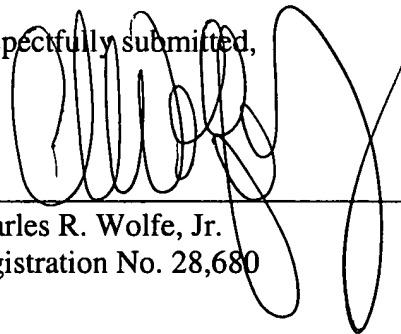
Applicant has responded to the Office action mailed February 26, 2003. A petition and fee for a one months extension of time is filed herewith. All of the claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (111869-00113). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,



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